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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,762	10/16/2003	Edward W. Gross	5175-155	8686
20792	7590	06/21/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			HAYES, BRET C	
			ART UNIT	PAPER NUMBER

3644

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/686,762

## Applicant(s)

GROSS ET AL.

## Examiner

Bret C Hayes

## Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                                 |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/16/2003</u> . | 6) <input type="checkbox"/> Other: ____.                                                |

Art Unit: 3644

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 6 – 9, 14 – 17, 23, 24 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 6 and 14 recite the limitation "a height", which has been previously recited in the base claim. Is this height new, separate and distinct from the original? If not, examiner suggests replacing "a" with --the--.
4. Claims 7 – 9, 15 – 17, 23, 24 and 29 recite a definite form of the limitation "free end" when the base claims recite "a free end portion". There is insufficient antecedent basis for this limitation in the claims.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 3, 8 – 12, 16 – 21 and 24 – 29 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,032,612 to Williams.
7. Re – claim 1, Williams discloses the claimed invention including an *in ovo* injection apparatus 10, comprising: an egg carrier 15 that holds a plurality of eggs 20 and provides

Art Unit: 3644

external access to the eggs 20; a plurality of injection devices 25 positioned above the carrier 15, wherein each injection device 25 is configured to contact a respective egg 20 in the carrier and deliver a predetermined dosage of a treatment substance into the egg 20 and/or remove material from the egg 20; and an egg support assembly, see Fig. 10, for example, positioned beneath the carrier 15 that is configured to support each egg 20 in the carrier 15 during contact therewith by a respective injection device 25.

8. Re – claim 2, Williams further discloses wherein the egg support assembly comprises: \*a frame, see Fig. 1, for example, movable between an operative position and a retracted position; a plate, best seen in Fig. 2, for example, attached to the frame and comprising an array of openings formed therein; and a plurality of pedestals, each pedestal removably secured within a respective one the openings, wherein each pedestal comprises a free end portion 26 configured to engage an egg 20 within the carrier 15 when the frame in the operative position. \*Regarding this rejection, Williams discloses, as best seen in Fig. 10, pedestals contacting the egg from both above and below. Williams does not explicitly state the construction of the lower egg support assembly. However, since Williams discloses that alteration of the device would be necessitated by injecting from both above and below, set forth at col. 9, line 51, it would be fair to take the disclosed structure of the upper assembly as a guide for the lower assembly.

9. Re – claim 3, Williams further discloses wherein the egg support assembly is operatively associated with the plurality of injection devices 25 such that each pedestal moves upwardly through a respective opening in the carrier 15 to support an egg 20 as a respective injection device 25 makes contact with the egg 20.

Art Unit: 3644

10. Re – claim 8, Williams further discloses wherein each pedestal free end portion 26 having a concave configuration.
11. Re – claim 9, Williams further discloses wherein each pedestal free end portion 26 comprises a wall inclined relative to a centerline of the pedestal between 25° and 55°.
12. Re – claim 10, Williams further discloses wherein the frame is movable via an actuator, see bottom of Figs. 1 and 2, for example.
13. Re – claims 11 – 12, 16 – 20, 24 and 25, Williams as applied above, discloses the claimed invention.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5 – 7, 13 – 15, 22, 23, 26, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams as applied above.
16. Re – claims 5, 6, 13, 14 and 22, Williams discloses the invention substantially as claimed as applied above. However, Williams does not disclose wherein a height of the free end portion of each pedestal relative to the plate is adjustable, and wherein the height of the free end portion of each pedestal relative to the plate is adjustable via one or more shims disposed between the free end portion and the plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust a height, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284

Art Unit: 3644

(CCPA 1954). Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use shims to adjust the height, since it was known in the art that shims are commercially available and have been used to adjust height in and make level constructions of all kinds. At Applicants request, examiner will provide prior art support.

17. Re – claims 7, 15 and 23, Williams discloses the invention substantially as claimed as applied above, including wherein each pedestal includes a proximal end portion 27 opposite from the free end portion 26 and the pedestal being fastened within a respective plate opening, see Figs. 1 and 2, for example. However, Williams does not disclose wherein an O-ring is secured to the proximal end of the pedestal that provides a snug, friction fit when the proximal end is disposed within a respective one of the plate openings. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an O-ring that is secured to the proximal end of the pedestal that provides a snug, friction fit, since the equivalence of any means for fastening and an O-ring for their use in the friction fitting art and the selection of any known equivalents to an O-ring would be within the level of ordinary skill in the art. At Applicants request, examiner will provide prior art support.

18. Concerning method claims 26, 27 and 29 in view of the structure disclosed by Williams, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.

19. Claims 4, 21 and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of US Patent No. 4,040,388 to Miller.

Art Unit: 3644

20. Re – claims 4 and 21, Williams discloses the invention substantially as claimed as applied above. However, Williams does not disclose the egg support assembly is configured to lift each egg from the carrier during contact with each egg by a respective injection device.

21. Miller teaches an egg support assembly 22 configured to lift each egg 14 from a carrier 10 during contact with each egg 14 by a respective injection device 60 in the same field of endeavor for the purpose of injecting *in ovo*. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include the lifting device as taught by Miller in order to inject *in ovo*.

22. Concerning method claim 28, in view of the structure disclosed by Williams in view of Miller, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (703) 306 – 4198. The fax number is (703) 872 – 9306.

bh

6/10/04

  
MICHAEL J. CARONE  
SUPERVISORY PATENT EXAMINER